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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,467	04/14/2004	Savvas Roubanis		8132

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EXAMINER

CONSILVIO, MARK J

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,467

Applicant(s)

ROUBANIS, SAVVAS

Examiner

Mark Consilvio

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/2/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 4/15/2003. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12/02/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

However, the listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

The use of the trademarks, "Notebook™" and "Velcro™," has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

Claim 1-30 are objected to because of the following informalities:

Claim 1 recites the limitation "said protection." However, there is not proper antecedent basis for this claim limitation. Similar instances occur throughout the claims and, where the element first appears as a claim limitation, "said" should be replaced by --a--. Appropriate correction is required.

Also, claim 1 recites the limitation "while at the same time operation of said equipment is made possible both on a table and on a lap of an operator." Since this implies simultaneous operation in different locations, the examiner suggests "and" be changed to --or--. Appropriate correction is required.

Regarding claims 1 and 29, the phrase "or something similar" could render the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or something similar"). Therefore, this language should be deleted or rewritten to encompass the exact scope desired.

Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

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claim(s) in independent form. The limitation, "said protection device according to any of said preceding claims" is an indication of dependency on, for example, claim 1.

Claims 2-28 and 30 inherit these problems stated supra problems at least through dependency of claims 1 and 29.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 28, and 29 contain the trademark/trade name, "Notebook™." Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe portable computer and, accordingly, the identification/description is indefinite.

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1, 28, and 29 recite the broad recitation, "electronic equipment," and the claim also recites "in particular a Notebook (portable computer) or a monitor," which is the narrower statement of the range/limitation. Also, claims 1, 28, and 29 recite the broad recitation, "said covering ... covers," and the claim also recites "preferably entirely" which is the narrower statement of the range/limitation. Likewise, similar problems arise in claims 8, 10, 19, 26, and 27. In all instances, this language should be avoided.

For the purposes of examination, due to the aforementioned problems associated with 1, 8, 10, 19, and 26-29, these claims will be examined as if these claims are limited to only their most broadly limited range interpreted in light of the disclosure.

Claims 2-28 and 30 inherit these problems stated supra problems at least through dependency of claims 1 and 29.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong (US Patent No. 5,988,823) in view of Easter (US Patent No. 5,800,067).

With respect to claims 1 and 28, Wong discloses a protection device (20) comprises a covering of flexible material with side panels (3, 10) and an opening (9 or whole front with flap up) for said operation or view of said electronic equipment, wherein said covering is, can be set under tension, is self-supporting, and covers said equipment, wherein a main extension plane of said opening in a functional condition of said protection device has an angle greater or equal to 90 degrees to a base (16) of said protection device (figs. 1-5).

Also, the examiner notes that the limitation, “for protection of electronic equipment against environmental influences and for protection against ambient light and with strong incident light associated glare, while at the same time operation of said equipment is made possible both on a table or on a lap of an operator,” is an intended use type limitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Wong does not expressly disclose that the device is at least partly self-erectable.

However, Easter teaches an at least partly self-erectable protection device for use with electronic equipment. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Wong and Easter to allow the protection device of Wong to be self-erectable. One of ordinary skill in the art would have been motivated to do this to ease the difficulty of assembling the device.

With respect to claim 2, Wong shows said main extension plane of said opening in said functional condition of said protection device is at least substantially vertical (figs. 4 and 5).

With respect to claim 3, Wong discloses said covering has a roof panel (14) which forms an upper and/or at least substantially horizontal limitation of said opening in said unfolded configuration of said protection device (fig. 4).

With respect to claim 4, Wong discloses said covering consists of one single piece (abstract).

With respect to claim 5, Wong shows said opening is defined by said front outlines of said side panels (3, 10) and a roof panel (14) (fig. 4).

With respect to claim 6, Wong discloses a level of a roof panel (14) inclines from a rear panel and said roof panel forms a highest point of said covering at a top margin of said opening (fig. 4).

With respect to claim 7, Wong discloses said protection device is transportable (col. 3, lines 1-6).

With respect to claim 8, Wong discloses said protection device consists exclusively of said covering.

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With respect to claim 9, Wong discloses said covering comprises a rear panel (15) and/or a floor (16).

With respect to claim 10, Wong discloses said side panels are connected preferably firmly and hinged along said horizontal edges with said floor and/or said roof panel, preferably by means of a seam (figs. 1-5).

With respect to claim 11, Wong discloses said side panels (3, 10) have substantially a same depth as a floor (16) and or a roof (14) (fig. 4).

With respect to claim 12, Wong discloses said protection device substantially forms a cubic or a pyramid shape in said unfolded condition (fig. 4).

With respect to claim 13, though Wong does not disclose said covering is made from a fabric or foil-like material, Easter teaches a covering of fabric. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to further combine the teachings of Wong and Easter to allow the covering to be made of fabric. One of ordinary skill in the art would have been motivated to do this to reduce cost and weight of the device.

With respect to claim 14, Wong discloses said covering or its material is at least one of water rejecting, waterproof, opaque, reflecting, flame resistant and incombustible.

With respect to claim 15, the combination of Wong and Easter suggests said side panels, said roof and/or said floor are respectively frame panels, wherein every frame panel comprises an integrated separate, flexible frame with closed geometry, whereas in particular each frame keeps said flexible material of said respective frame panel under constant, biaxial tension, and forms in said expanded condition a single loop and in said collapsed condition three loops lying one above said other. At the time the invention was made, it would have been obvious to a

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person of ordinary skill in the art to combine the teachings of Wong and Easter to provide these features. One of ordinary skill in the art would have been motivated to do this to allow the device to be properly self-erectable (See Easter figs. 1-7).

With respect to claim 16, Easter discloses or suggests the frame is led and integrated in a seam or a tubular form of fabric material which is attached along said edge of said respective frame panel, preferably sewn on. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Wong and Easter to provide these features. One of ordinary skill in the art would have been motivated to do this to provide an inexpensive means of manufacture.

With respect to claim 17, Easter discloses said covering can be set under tension by means of frame. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Wong and Easter to provide these features. One of ordinary skill in the art would have been motivated to do this to allow the device to remain erected without additional supports.

With respect to claim 18, Easter discloses said frames are preferably flat in said cross section. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Wong and Easter to provide these features. One of ordinary skill in the art would have been motivated to do this to allow the device to be folded into its smallest arrangement requiring the least amount of space

With respect to claim 19, Wong discloses said opening extends over one side, in particular said front of said protection device (fig. 4).

With respect to claim 20, Wong discloses said opening can at least partly close (fig. 5).

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With respect to claim 21, Wong discloses said covering comprises visors (on either side of element 9) assigned to said opening, said roof and/or said side panels (fig. 5).

With respect to claim 22, Wong discloses said visors are adjustable and/or removable and/or are hinged and can be clapped in and/or out (fig. 5).

With respect to claim 23, though Easter teaches rounded corners for the covering, Wong and Easter do not disclose rounded corners has a radius is 10 cm or less. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Wong and Easter to provide these features since it has been held that changes in size and shape are a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed device is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966), *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). One of ordinary skill in the art would have been motivated to do this to allow the device to be properly sized for a laptop computer.

With respect to claim 24, Wong and Easter do not disclose said covering has fastening means for said attachment of said protection device like loops or rings. However, such means for attachment are well known in the art. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Wong and Easter to provide these features. One of ordinary skill in the art would have been motivated to do this to allow the device to be easily fastened in place preventing unintentional movement or adjustment.

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With respect to claim 25, Easter discloses a covering has additionally at least a further said opening for said supply of cables and/or ventilation (col. 3, lines 60-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Wong and Easter to provide these features. One of ordinary skill in the art would have been motivated to do this to allow easy access for power cord or the like.

With respect to claims 26 and 27, Wong discloses said protection device is collapsible into a flat configuration but is silent to its exact size and weight. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Wong and Easter to provide the necessary features since it has been held that changes in size and shape are a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed device is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966), *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). One of ordinary skill in the art would have been motivated to do this to allow the device to be properly sized for a laptop computer.

With respect to claims 29 and 30, the combination of Easter and Wong disclose or suggest all the limitations of claim 1 as stated supra. Also, Easter suggests a method of collapsing a protection device comprising several frame panels, wherein said frame panels are first laid flat one on said other and afterwards together collapsed by twisting a, at least substantially even, loop forming frame in said extended condition of said respective frame panels. At the time the invention was made, it would have been obvious to a person of ordinary

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skill in the art to combine the teachings of Wong and Easter to provide these features. One of ordinary skill in the art would have been motivated to do this to allow the device to be folded into its smallest arrangement requiring the least amount of space.

Conclusion

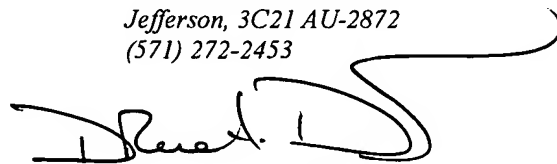
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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